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APPLICATION NUMBER 67/427,345	FILING DATE 10/26/99	FIRST NAMED APPLICANT SAKAGAWA	ATTY. DOCKET NO. K FUSA-12.689A
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LM02/0502

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EXAMINER
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ART UNIT	PAPER NUMBER
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2756

DATE MAILED:

05/02/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.
- ☐ Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-39 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d):
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. The following is a statement of 37 CFR 3.73, which became effective on September 4, 1992, and was revised to its present form in 1997:

**37 CFR 3.73 Establishing right of assignee to prosecute.**

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application unless there is an assignment.

(b) When an assignee seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

Applicant is required to submitted to the Office the reel and frame number of where the assignment is located.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: It does not state whether the inventor is a sole or joint inventor of the invention claimed.

3. The disclosure is objected to because applicant merely state in the Preliminary remarks filed on 10/26/1999 that "the inventor indicated that the description relating to the use of a broadcast method of broadcasting an interrogation request to all terminals in an ATM was not known or reduced to practice by others before the priority date of this application, but was in fact his own idea". As a result, applicant rearrange the specification relating to this method as part of the new invention rather than part of the background invention. Applicant is required to provide evidence to prove that the method is part of the new invention, or the specification can not be modified as submitted in the Reissue Application.

4. Claims 1-39 are presented for examination.

5. Claims 2-3 are objected to because of the following informalities: Typographical error of the word "step" in line 2 of claims 2-3. Appropriate correction is required.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-39 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Sakagawa's admitted prior art** in patent no. **5,774,662**, in view of "**Address Resolution Protocol**" by Finn.

8. As to claim 16, Sakagawa's admitted prior art teaches the invention as claimed, including a network system having a server (ATM LAN server 3, figure 24 PRIOR ART), the method comprising the steps of:

receiving by the server a terminal address interrogation request including a first address from an originating terminal (col. 2 line 62 - col. 3 line 13);

referring by the server to an address table and searching by the server for the second address corresponding to the first address included in the terminal address interrogation request (col. 2 line 62 - col. 3 line 13);

However, Sakagawa's admitted prior art does not explicitly teach transferring by the server the terminal address interrogation request including the first address to a plurality of terminals.

Finn teaches LE server must forward any LE\_ARP\_REQUEST for an unregistered LAN destination to all LE clients (page 5, SEC. 6.2.8).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Finn into Sakagawa's admitted prior art to forward the first address to other terminals because it would provide address resolution for the first address.

9. As to claim 17, Sakagawa's admitted prior art teaches the invention as claimed, including a network system having a server (ATM LAN server 3, figure 24 PRIOR ART), the method comprising the steps of:

receiving by the server a terminal address interrogation request including a first address from an originating terminal (col. 2 line 62 - col. 3 line 13);

identifying by the server a second address based on the first address included in the terminal address interrogation request sent from the originating terminal (col. 2 line 62 - col. 3 line 13); and

However, Sakagawa's admitted prior art does not explicitly teach transferring by the server the terminal address interrogation request including the first address to a

plurality of terminals when the server cannot identify the second address corresponding to the first address based on the first address.

Finn teaches LE server must forward any LE\_ARP\_REQUEST for an unregistered LAN destination to all LE clients (page 5, SEC. 6.2.8).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Finn into Sakagawa's admitted prior art to forward the first address to other terminals if the server does not have the second address corresponding the first address or the first address is not registered with the server because it would provide address resolution for the first address.

10. As to claim 18, Sakagawa's admitted prior art teaches receiving and transferring the terminal address interrogation request uses ATM cells (col. 1 line 65 - col. 2 line 35).

11. As to claim 19, Sakagawa's admitted prior art teaches identifying step includes: searching in an address table for the second address corresponding to the first address included in the terminal address interrogation request (col. 2 line 62 - col. 3 line 13).

12. As to claim 20, Sakagawa's admitted prior art inherently teaches a switch or exchange and wherein the transferring step includes: a step in which the switch or exchange connects the server with the plurality of terminals by PVCs (permanent virtual channels) having identical values; and a step in which, when the terminal address

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interrogation request in the form of a cell and having the identical value for the PVC is entered for the server, the switch or exchange performs cell copying. whereby the terminal address interrogation request cell is transferred to the plurality of terminals (inherent features can be found in **Burnett et al** patent no. **5,633,869**).

13. As to claim 21, Finn and Sakagawa's admitted prior art inherently teaches a switch or exchange, and wherein the transferring step includes: a step in which the switch or exchange connects the server with the plurality of terminals by PVCs (permanent virtual channels) having identical values and divides the plurality of terminals into a plurality of groups, a step in which, when the terminal address interrogation request in the form of a cell and having the identical value for PVC is entered from the server, the switch or exchange performs cell copying, whereby the terminal address interrogation request cell is transferred in a first group, a step in which the server performs monitoring to determine whether a prescribed terminal has answered with its own address within a set period of time; a step in which the server sends the terminal address interrogation request cell to terminals of the next group when no terminal answers with its own address with the set period of time, and a step in which the server transfers the terminal address interrogation request while successively changing the group until a prescribed terminal answers with its own address (Finn, pages 4-5, SEC. 6.1.8, 6.1.12, 6.2.6, 6.2.8 ; inherent features can be found in **Burnett et al** patent no. **5,633,869**).

14. As to claim 22, Finn and Sakagawa's admitted prior art teaches receiving by the server an answer including a second address corresponding to the first address from one of the plurality of terminals when the first address included in the terminal address interrogation request received by the one terminal is in agreement with its own first address-, and notifying by the server to the originating terminal of the second address corresponding to the first address (Sakagawa, col. 2 line 62 - col. 3 line 13; Finn, page 2, SEC. 6.0, 6.2.8).

15. As to claim 23, Finn and Sakagawa's admitted prior art teaches the server receives the answer including a second address from the one of the plurality o terminals, the server stores, in an address table, the corresponding relationship between the first address and the second address, of which it has been notified (Sakagawa, col. 2 line 62 - col. 3 line 13; Finn, page 2, SEC. 6.0, 6.1.4, 6.2.8).

16. As to claim 24, Finn and Sakagawa's admitted prior art teaches the server receives the answer including a second address from the one of the plurality o terminals, the server stores the corresponding relationship between the first address and the second address in place of the address table designated by an index value which is calculated based on a value of the first address or the second address (Sakagawa, col. 2 line 62 - col. 3 line 13; Finn, page 2, SEC. 6.0, 6.1.4, 6.2.8).



17. As to claim 25, Finn and Sakagawa's admitted prior art teaches the invention substantially as discussed above; however, they do not explicitly teach deleting a corresponding relationship, referred to least recently, between a first address and a second address when the address table is full.

Official Notice is taken that deleting least recently entry in a table when a table is full is well known.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the well known feature with teachings of Finn and Sakagawa's admitted prior art to delete a corresponding relationship, referred to least recently, between a first address and a second address when the address table is full, and store, in the address table, the new corresponding relationship between the first address and the second address because it would update the address table with the corresponding relationship between the first address and the second address.

18. As to claim 26, Finn and Sakagawa's admitted prior art teaches the server periodically receives a terminal address interrogation request including a second address from each terminal of the plurality of terminals, whereby the corresponding relationship between the first address of its own terminal and the second address is kept in an address table (Sakagawa, col. 2 line 62 - col. 3 line 13; Finn, pages 2 and 4, SEC. 6.0, 6.1.2, 6.1.12).

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19. Claims 1-15 and 27-39 have similar limitations as claims 16-26; therefore, they are rejected under the same rationale.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank J. Asta, can be reached at (703) 305-3817.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

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Or:

(703) 305-7201 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington. VA., Sixth Floor (Receptionist).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', written over a horizontal line.

**LE HIEN LUU**  
**PRIMARY EXAMINER**

April 14, 2000